

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of Linda M. Dorschner Art Unit 3761
Serial No. 10/034,846
Filed December 28, 2001
Confirmation No. 9653
For RATIO OF ABSORBENT AREA TO OUTER PERIPHERAL AREA FOR
DISPOSABLE ABSORBENT ARTICLES
Examiner Karin M. Reichle

October 1, 2009

REPLY BRIEF

This is a reply to the Examiner's Answer mailed August 14, 2009.

In support of her rejection of claims 83-93, 100-102, and 106-111 under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement, the Examiner explained that "[a] cursory review of the application did not reveal the support for such combination." See page 4, lines 7 and 8 of the Examiner's Answer. However, a "cursory review" of appellants' application is insufficient to establish a *prima facie* rejection based on the written description requirement of 35 U.S.C. §112, first paragraph.

As explained in M.P.E.P. § 2163.04¹, "[t]he examiner has the initial burden of presenting by a preponderance of evidence why a person skilled in the art would not recognize in an applicant's disclosure a description of the invention defined by the claims." Emphasis added. Clearly, a rejection based on a "cursory review" of the application fails to meet this standard. Thus, the Examiner failed to establish a *prima facie* rejection under 35 U.S.C. §112, first paragraph since

¹ M.P.E.P. § 2163.04 cites to *Wertheim*, 541 F.2d at 263, 191 USPQ at 97.

the Examiner by failing to show beyond a preponderance of evidence why a person skilled in the art would not recognize that the applicant's disclosure has a description of the invention defined by the claims.

In addition, the Examiner asserts that the Appellants' reliance on Figures 1 and 2 and paragraphs 57 and 123 of the specification as providing support for these claims is insufficient to support the claims. See page 4, lines 15-17 and 20-22 of the Examiner's Answer. However, Appellants do not rely on Figures 1 and 2 or cite to paragraphs 57 and 123 of the specification. Rather, Appellants rely on Figure 3 and page 27, lines 8-10 and 15-17 of Appellants' specification. See pages 6-9 of Appellants' Appeal Brief. Appellants fully explained how the claims pending in this application are supported by at least these portions of Appellants' application in their Appeal Brief and, therefore, will not repeat their positions herein.

In addition to the reasons set forth in Appellants' Appeal Brief, Appellants request that the Examiners' rejections of the claims as not satisfying the written description requirement of 35 U.S.C. §112, first paragraph, be reversed for failing to establish a *prima facie* case.

With respect to the claims being obvious in view of the combination of Roe et al., Alemany et al., Morman et al. and Divo et al., the Examiner takes the position that the claimed "surface area" of the absorbent core could include its thickness. Appellants disagree and contend that the specification clearly explains that the "surface area" of the absorbent core as recited in the claims is defined by its length and width and is entirely independent of its thickness.

Each of the independent claims pending in this application (i.e., claims 107, 109, and 111) recite that the absorbent core has "a surface area which is less than about 50% of the surface area of the article." As explained on page 35 of Appellants' specification and illustrated in Figure 6, the surface area of the various embodiments of absorbent core are calculated using only its respective length and width. See, e.g., lines 4-27. Notably, the thickness of the absorbent core is not even mentioned nor is it seen in Figure 6. Figure 6, which shows the entire surface area of one embodiment of the absorbent core, is a top plan, two dimensional view showing only the length and width of the absorbent core. Based on Appellants' specification taken as a whole, one skilled in the art would certainly recognize that the claimed surface area is limited to the length and width of the absorbent core and does not include any thickness component.

Thus, the Examiner's reliance on the thickness differential present in the absorbent core of Alemany et al. as being a factor in its surface area is misplaced with respect to the claims pending in this application. The thickness of the absorbent core of Alemany et al. (or any other reference) has no bearing on the claimed invention.

Accordingly, the Examiner's rejection of the claims pending in this application as being obvious in view of the combination of Roe et al., Alemany et al., Morman et al. and Divo et al. should be reversed.

Conclusion

In addition to the reasons set forth in the Appellants' Appeal Brief, the rejections of the claims on appeal are submitted to be in error for the reasons set forth above.

Appellants do not believe that any fee is due. However, the Commissioner is hereby authorized to charge any deficiency or overpayment of any fees to Deposit Account No. 12-384.

Respectfully submitted,

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